

REMARKS

Claims 1-57 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Double Patenting Rejection:

The Office Action provisionally rejected claims 1, 11, 20, 30, 39, 49, 8, 17, 27, 36, 46 and 55 under the judicially-created doctrine of nonstatutory obviousness-type double patenting as being unpatentable over claims 13, 14, 27, 28, 41, 13, 14, 27, 28, 41 and 42 of copending Application No. 10/670,550. Also, the Office Action provisionally rejected claims 1, 11, 20, 30, 39, 47, 49, 56, 9, 18, 28 and 37 under the judicially-created doctrine of nonstatutory obviousness-type double patenting as being unpatentable over claims 9, 10, 19, 20, 29, 30, 9, 10, 18 and 20 of copending Application No. 10/670,549. Applicant acknowledges the provisional rejections and will address them when and if they should become non-provisional.

Section 102(b) Rejection:

The Examiner rejected claims 1-5, 7, 10-16, 18-24, 26, 28-35, 37-43, 45, 47-54, and 56-57 under 35 U.S.C. 102(e) as being anticipated by McDowell (Patent Application Publication No. US 2002/0035605 A1) (hereinafter “McDowell”), claims 1, 8, 11, 17, 20, 27, 30, 36, 39, 46, 49 and 55 as being anticipated by Aravamudan, et al. (U.S. Patent 6,301,609) (hereinafter “Aravamudan”). Applicants respectfully traverse this rejection in light of the following remarks.

Regarding claim 1, neither McDowell nor Aravamudan teach or suggest, either separately or in combination, a method comprising receiving an instant messaging operation directed to a given user, wherein said given user is not offline; determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively

processing said instant messaging operation dependent upon said presence state in response to said determining.

Regarding claim 11, neither McDowell nor Aravamudan teach or suggest, either separately or in combination, a method comprising storing an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to an online given user; detecting a transition to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting.

1. McDowell fails to anticipate the independent claims.

In rejecting claim 1, the Examiner cites McDowell as disclosing “the integration of presence determination, location determination, [and] instant messaging.” McDowell at para. 14. The Examiner also refers to McDowell’s Table 1 as disclosing “several presence states which are not offline,” and asserts that McDowell’s disclosure regarding “query[ing] the presence server 112 before attempting to send a message, eliminating inefficient retry attempts,” McDowell at para. 53, discloses “selectively processing the instant messaging operation” as recited in claim 1. The Examiner finally asserts that McDowell’s Table 5 discloses that users may indicate days and times they do not wish to “receive messages,” and concludes that this discloses that “a user can have his phone on and be in a state that is not offline while deciding to be in a busy presence state and not receive messages.” Applicant traverses the Examiner’s assertions and notes that McDowell fails to anticipate claim 1 for at least the following reasons.

A. McDowell fails to disclose determining a presence state of an instant messenger in response to receiving an instant messaging operation.

Contrary to the Examiner’s assertion, the states disclosed by McDowell in Table 1 are not presence states of an instant messenger, as required by claim 1, but instead are states that are specific to a particular wireless or mobile device. McDowell at para. 34,

45. Column 1 of Table 1 specifically refers to wireless device status. While Table 1 provides for a wireless device status that includes a user defined state, it remains the case that this state is a presence state of a wireless device and not an instant messenger.

The fact that McDowell distinguishes wireless device status as a distinct type of presence information is evident from the ON – WAP state, which specifically is defined as “phone is ON and subscriber is using the WAP instant messaging application.” If table 1 disclosed presence states of an instant messenger, then instant messaging would be relevant to all of the states listed in Table 1. Instead, McDowell calls out one particular device state as indicative of the case that an instant messaging application is being used, thus indicating that instant messaging is in fact not relevant to the other listed device states.

In Table 2 and at paragraphs 59–62, McDowell describes several “internet presence” states. However, McDowell does not disclose that any of these states is determined in response to receiving an instant messenger operation. Instead, McDowell states that to determine internet presence, “[t]he Presence Server communicates peer-to-peer with IM servers.” McDowell at para. 62. McDowell does not disclose that such communication occurs in response to receiving an IM operation. In fact, in the only indication McDowell appears to provide regarding the timing with which presence information is accessed, McDowell states that “[t]he Campaign Manager queries the Presence Server to know if a particular subscriber's phone is ON or OFF before attempting to send a targeted mobile commerce message.” McDowell at 56, emphasis added. Apart from the differences in the type of presence information and the type of messaging involved, querying for device status before sending a message suggests the opposite timing from that required by claim 1, in which an instant messenger presence state is determined in response to receiving an instant messaging operation.

B. McDowell fails to disclose selectively processing an instant messaging operation dependent upon an instant messenger presence state in response to determining the presence state.

The Examiner asserts that McDowell's statement in paragraph 53, regarding querying the presence server prior to attempting to send a message, discloses selective processing of an instant messaging operation as recited in claim 1. Applicant disagrees. As noted above, McDowell fails to disclose determining a presence state of an instant messenger in the manner required by claim 1. More specifically, as noted above, McDowell distinguishes device-level status information from instant messenger presence state information. At paragraph 53, McDowell is referring not to presence state information of an instant messenger, but to the ON/OFF device-level status information referred to in Table 1. Thus, to the extent McDowell discloses any type of selective processing, it is selective processing dependent upon the state of a device, not presence state of an instant messenger, as required by claim 1.

As to McDowell's disclosure in Table 5 regarding the ability of users to indicate days and times they do not wish to "receive messages," the items reflected in Table 5 are not indicative of presence state of an instant messenger. Instead, they are privacy preferences that are managed by subscribers through a "Privacy Management System" accessible via a secure Web or WAP interface. McDowell at para. 130–132. These items simply have nothing to do with presence state of an instant messenger. Rather, they represent a different class of information (privacy information) upon which information delivery may be conditioned. Simply because McDowell may disclose that delivery of a message may be contingent upon some sort of state, such as privacy information or device status information, does not entail that McDowell discloses selective processing of an instant message dependent upon a presence state of an instant messenger, as recited in claim 1.

Because McDowell fails to disclose numerous features of claim 1 as set forth above, McDowell cannot be said to anticipate claim 1. Similar arguments apply to similar independent claims 20 and 39.

In rejecting claim 11, the Examiner asserts that at paragraph 53, McDowell discloses that a short message service (SMS) center may “query the Presence Server . . . before attempting to send a message, eliminating inefficient retry attempts” and asserts that “[i]t is inherent that the message must have been stored in order to send it later.” Applicant traverses the Examiner’s remarks for at least the following reasons.

C. McDowell does not disclose storing an instant messaging operation associated with a given presence state.

Regardless of the accuracy of the Examiner’s statement regarding the “inherency” of McDowell’s storing a message, Applicant notes that claim 11 does not merely recite that an instant message is stored, but that an instant messaging operation is stored. Further, the stored operation is associated with a given presence state of an instant messenger. McDowell simply fails to disclose that there is any type of association between a stored instant messaging operation and a given presence state.

D. McDowell fails to disclose detecting a transition to the given presence state or responsively performing the stored instant messaging operation.

The Examiner does not address these features of claim 11. However, McDowell is completely silent as to the required claim features of detecting a transition to a given presence state. Moreover, McDowell does not disclose any aspect in which in response to detecting such a presence state transition, a stored instant messaging operation that is associated with the given presence state (i.e., the presence state to which a transition was detected) is then performed.

Because McDowell fails to disclose numerous features of claim 11 as set forth above, McDowell cannot be said to anticipate claim 11. Similar arguments apply to similar independent claims 30 and 49.

2. Aravamudan fails to anticipate the independent claims.

In rejecting claim 1, the Examiner cites Aravamudan as disclosing “instant messaging with presence detection” at col. 7, lines 15-16. The Examiner further asserts that Aravamudan discloses selective processing of messages, referring to Aravamudan’s priority assignment scheme discussed at col. 2, paragraph 2. Finally, the Examiner refers broadly to Figures 6 and 8 and col. 8, lines 64-68, col. 9, lines 10-20 and col. 9, lines 25-35 of Aravamudan as disclosing “presence states that are not offline and for which the active and inactive states which are not offline have messages which are selectively processed.” Applicant traverses the Examiner’s assertions and notes that Aravamudan fails to anticipate claim 1 for at least the following reasons.

A. Aravamudan fails to disclose determining a presence state of an instant messenger in response to receiving an instant messaging operation.

First, and most generally, Aravamudan does not disclose any aspect of determining a presence state of an instant messenger. Aravamudan describes that a CPE device monitors for general user activity, and if such activity is detected, the CPE device generates and conveys an active message to the CSP via an IM server. Aravamudan makes no mention whatsoever of presence states of an instant messenger. To the extent Aravamudan describes “state” at all, it is in broadly referring to the state of the entire CPE device, e.g., as active or inactive, based on the monitored user interaction with the device. In Aravamudan, detected user interaction and the corresponding active message are specific to the CPE device as a whole, not to an instant messenger that might be executing on that device.

Also, Aravamudan fails to disclose that presence state is determined in response to receiving an instant messaging operation. With regard to the Examiner’s reference to col. 7, lines 15-16, in which Aravamudan discloses that “[t]he IM server also notifies selected buddies to the user of the user[’]s presence online,” Applicant notes that this activity occurs in response to the user’s initially logging on to the network, not receipt of

an instant messaging operation. Aravamudan at col. 6, line 64 – col. 7, line 3. Applicant further notes that Aravamudan describes a situation in which an “important event” is received and an instant message corresponding to the event is responsively generated. *Id.* at col. 8, line 32 – col. 9, line 44. However, out of a number of enumerated possibilities to which such an important event could correspond, Aravamudan specifically omits to mention receiving an instant messaging operation. Applicant notes that generating an instant message in response to an important event, as in Aravamudan, is not suggestive of determining a presence state of an instant messenger, as required by claim 1.

B. Aravamudan fails to disclose selectively processing an instant messaging operation dependent upon an instant messenger presence state in response to determining the presence state.

The Examiner suggests that Aravamudan’s “notify[ing] selected buddies” corresponds to selectively processing an instant messaging operation. However, as noted above, this discussion of Aravamudan describes what occurs in response to the user’s initially logging on to the network. In this instance, there is simply no instant messaging operation to be selectively processed. Further, as noted above, Aravamudan does not perform such notification dependent upon an instant messenger presence state, but rather on a device state.

The Examiner further asserts that Aravamudan’s discussion regarding assigning various levels of priority to different users (as mentioned at col. 2, paragraph 2, and in greater detail at col. 9, line 45 – col. 11, line 5) discloses selective processing of instant messaging operations. However, the assignment of priorities to various “buddies” simply has nothing to do with selective processing of instant messaging operations dependent upon an instant messenger presence state. In Aravamudan, the priorities assigned by a user to his/her various buddies are entirely dependent upon that user’s preferences regarding the buddies. Such preferences reflect the relative importance of various ones of the user’s buddies, and do not depend on instant messenger presence state.

Because Aravamudan fails to disclose numerous features of claim 1 as set forth above, Aravamudan cannot be said to anticipate claim 1. Similar arguments apply to similar independent claims 20 and 39.

In rejecting claim 11, the Examiner asserts that Aravamudan, col. 8, line 32 – col. 9, line 44 discloses the recited claim features. Applicant traverses the Examiner’s assertion for at least the following reasons.

C. Aravamudan does not disclose storing an instant messaging operation associated with a given presence state, where the presence state corresponds to an online user.

As discussed above, the cited passage of Aravamudan describes a situation in which an “important event” is received. The Examiner asserts that Aravamudan’s statement that “[i]mportant events include any data, communication, or notification received for the user” implies that an important event can be an instant messaging operation. Applicant traverses the Examiner’s assertion and reiterate that as noted above, Aravamudan describes numerous different types of events that could corresponding to “important events” without mentioning instant messaging operations among them. When taken as a whole, it is clear from this passage that Aravamudan is discussing the generation of an instant message in response to detecting some other type of event.

Since the “important event” that triggers generation of an instant message in Aravamudan is clearly some event other than an instant message, the fact that the important event may be “held in abeyance” is immaterial to claim 11’s requirement that it is the instant messaging operation that is stored, rather than some other event that triggers an instant message. Moreover, Applicant notes that Aravamudan discloses that the important event is held in abeyance in response to determining that the user is offline. Aravamudan, col. 8, lines 56-57. This is the **opposite** of claim 11’s requirement that the instant messaging operation that is stored be associated with a presence state that corresponds to an online user.

D. Aravamudan fails to disclose performing the stored instant messaging operation in response to detecting a transition to the given presence state.

As noted above, Aravamudan's "important event" held in abeyance is not a stored instant messaging operation, but at most a stored event of some other type that may trigger an instant message. Aravamudan discloses that "[t]he CSP then initiates an instant message to the user only when the status of the user is once again registered as online." Aravamudan at col. 9, lines 5-7, emphasis added. That is, in Aravamudan, no instant message is even generated in response to the pending event until the user is once again online. Thus, Aravamudan does not disclose performing an instant messaging operation that was stored in association with a given presence state prior to detecting a transition to that given presence state. Rather, Aravamudan discloses generating an instant message only when the user is once again online. The sequence of operations disclosed by Aravamudan is thus substantially different from that required by claim 11.

Because Aravamudan fails to disclose numerous features of claim 11 as set forth above, Aravamudan cannot be said to anticipate claim 11. Similar arguments apply to similar independent claims 30 and 49.

3. Summary

Applicant notes that that anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. M.P.E.P 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The **identical invention must** be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). In view of the substantial omissions in McDowell and Aravamudan noted above with respect to the independent claims, these references clearly fail to meet the standard of anticipation.

Section 103(a) Rejection:

The Office Action rejected claims 6, 25 and 44 under 35 U.S.C. § 103(a) as being unpatentable over McDowell and further in view of Generous, et al. (U.S. Publication 2002/0120697) (hereinafter Generous). Applicant notes that Generous fails to remedy the omissions of McDowell and Aravamudan with respect to the independent claims and submits that this rejection is unsupported for at least the reasons given above.

Applicant also notes that the rejections of numerous ones of the dependent claims are further unsupported by the cited references. However, as the rejections of the independent claims have been shown to be unsupported, further discussion of the dependent claims is unnecessary at this time.

CONCLUSION

Applicant submits the application is in condition for allowance, and notice to that effect is requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-69900/RCK.

Respectfully submitted,

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